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OFFICE OF PETITIONS

In re Patent No. 7,557,105 :
Bornsen et al. :
Issue Date: July 7, 2009 :
Application No. 10/502,291 : DECISION ON REQUEST FOR
Filed: April 29, 2005 : RECONSIDERATION OF
Attorney Docket No. ON/4-32325A : PATENT TERM ADJUSTMENT
Title: N-Oxyde Of N-Phenyl-2- :
Pyrimidine-Amine Derivatives :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT-POST-GRANT", filed September 3, 2009. This petition is properly treated under 37 CFR 1.705(d). Patentees request the final Patent Term Adjustment calculation to increase from 330 days to 748 days.

The application for reconsideration of patent term adjustment is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **five hundred thirty-seven (537) days**.

The above-identified application matured into U.S. Patent No. 7,557,105 on July 7, 2009. The patent issued with a patent term adjustment of 330 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See, 37 CFR 1.705(d).

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to Wyeth, a PTO delay under 35 U.S.C. §154(b)(1)(A) overlaps with a delay under 35 U.S.C. §154(b)(1)(B) only if the delays "occur on the same day." Patentees maintain that the period of

adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), 418 of 538 days, does not overlap with the 508 day period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a), as these periods do not occur on the same day. Thus, patentees request that the determination of patent term adjustment be increased to a total of seven hundred forty-eight (748) days (the sum of the period of three-year delay (538 days) and the period of examination delay (508 days) less 120 days of overlap less 178 days of applicant delay).

As stated in 37 CFR 1.703(b), the period of adjustment under § 1.702(b) is the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the periods under § 1.703(b)(1)-(4). While the date of completion of all 35 U.S.C. 371 requirements, April 29, 2005, is the date used in calculating examination delay under 37 CFR 1.703(a), the date the national stage commenced under 35 U.S.C. 371(b), Monday, July 23, 2004, is used in determining the Three Year Delay under 37 CFR 1.703(b).

Pursuant to 37 CFR 1.703(b)(1), the period of adjustment under 37 CFR 1.702(b) should be 715 days, counting the number of days beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(b), July 24, 2007, and ending on the date the patent issued, July 7, 2009.

At issue is whether patentees should accrue 715 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 508 days for Office failure to take certain actions within specified time frames (or examination delay).

Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the

patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the national stage commenced overlap with the actual dates in the periods for failure of the Office to take action within specified time frames.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the national stage commenced, July 23, 2004, to the issuance of the patent on July 7, 2009. 508 days of patent term adjustment were accorded prior to the issuance for Office delay pursuant to 37 CFR §1.702(a)(1). Entry of both 715 days pursuant to 37 CFR §1.702(b) and 508 days pursuant to 37 CFR §1.702(a) is neither permitted nor warranted. The Office did not delay 715 days and then another 508 days. The greater period, 715 days, is the actual number of days issuance of the patent was delayed by the Office. All but 207 days of the periods pursuant to 37 CFR §§1.702(a) and 1.702(b) overlap. Accordingly, at issuance the Office should have entered an additional 207 days of patent term adjustment for taking in excess of three months to issue the patent for a total Office delay of 715 days.

The period of adjustment of 330 days will be removed and a period of adjustment of 537 days will be entered.

In view thereof, the patent term adjustment indicated on the patent should be five hundred thirty-seven **(537) days** ((508 + 207) - 178) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Patentees are given THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer, from the mail date of this decision to respond to this decision. No extensions of time will be granted under § 1.136.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by five hundred thirty-seven (537) days.

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Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant, at (571) 272-3215.

/ALESIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,557,105 B2

DATED : July 7, 2009

INVENTOR(S) : Bornsen et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (330) days

Delete the phrase "by 330 days" and insert – by 537 days--